REMARKS

In the Office Action mailed January 8, 2007,[1] the Examiner rejected claims 10, 16, 17, 27, 33, 34, 45, 50, and 51 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,792,577 by Kimoto ("Kimoto"); and rejected claims 1-9, 11-15, 18-26, 28-32, 35-43, and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Kimoto in view of International Publication No. WO 02/27486 to Barber ("Barber").

Claims 1-5, 7, 8, 10-12, 14-16, 18-22, 24, 25, 27-29, 31-33, 35-39, 41, 42, 44-46, and 48-50 remain pending. Applicant cancels claims 6, 9, 13, 17, 23, 26, 30, 34, 40, 43, 47, and 51.

In the Office Action, the Examiner objected to claims 7, 14, 15, 24, 31, 32, 41, 48, and 49 for failing to provide proper antecedent basis. Applicant amends these claims to provide proper antecedent basis and therefore respectfully requests that the Examiner withdraw the objection.

Applicants respectfully traverse the rejection of claims 10, 16, 17, 27, 33, 34, 44,[2] 50, and 51 under 35 U.S.C. § 102(e) as being anticipated by ("Kimoto"). To properly establish that Kimoto anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

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[1] The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

[2] The Office Action indicates claim 45 is rejected as being anticipated by Kimoto. Office Action at 2. Applicant believes this to be a typographical error that should read "claim 44."

Kimoto does not disclose each and every element of Applicant's claimed invention. Independent claim 10 calls for a combination including, for example, "a method for communicating a data element <u>in an ASN.1 PER standard format</u> in a way that does not identify the format of the element" including "receiving the data element; [and] extracting a unique identifier that specifies the format of the data element and <u>indicates, using recursion, whether the data element references itself</u>" (emphasis added). Kimoto fails to teach or suggest at least an "ASN.1 PER standard format" and use of "recursion." Indeed, the Examiner concedes that Kimoto does not teach these elements. Office Action at 3.

Accordingly, Kimoto cannot anticipate independent claim 10 and dependent claims 16 and 17. Independent claims 27 and 44, although of different scope than claim 10, patentably distinguish from Kimoto for at least the same reasons as claim 10. Claims 33, 34, 50, and 51 depend from independent claims 27 and 44 and therefore include all of the elements recited therein. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of pending claims 10, 16, 27, 33, 44, and 50 as being anticipated by Kimoto.

Applicant respectfully traverses the rejection of claims 1-9, 11-15, 18-26, 28-32, 35-43, and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Kimoto in view of Barber because a *prima facie* case of obviousness has not been established.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must

both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither Kimoto nor Barber, taken individually or in combination, teaches or suggests each and every element of Applicants' claims.

Independent claim 1 calls for a combination including, for example, a "method for communicating a data element in an ASN.1 PER standard format in a way that does not identify the format of the element" including "creating a unique identifier, the unique identifier specifying the format of the data element and identifying, using recursion, whether the data element references itself" (emphasis added). As discussed above, Kimoto fails to teach or suggest at least an "ASN.1 PER standard format" and use of "recursion." Barber fails to cure the deficiencies of Kimoto.

In rejecting previously pending claim 6, the Examiner alleged that Barber discloses the claimed "recursion" on page 9, lines 21-31. This is incorrect. Neither page 9 nor any other portion of Barber teaches or suggests "recursion" for "identifying . . . whether the data element references itself," as recited by amended claim 1.

Moreover, neither Kimoto nor Barber teaches or suggests "communicating a data element in an ASN.1 PER standard format," as recited by claim 1. The Examiner concedes this (Office Action at 6), but nevertheless asserts "it would have been obvious . . . to transmit the data element in the ASN.1 PER standard format since this standard was well known . . . ." Id. Applicants disagree. Even assuming the ASN.1 PER standard was well known, there is no teaching or suggestion in Kimoto or Barber of using the ASN.1 PER standard with an "unique identifier specifying the format of the data element and identifying, using recursion, whether the data element references

itself," as recited by claim 1. Rather, the ASN.1 PER standard "includes very little metadata when serialized, which allows data to be transmitted more quickly." Applicant's Specification at 7. Therefore, the Examiner's bare assertion that the ASN.1 PER standard was "well known" does not constitute the requisite motivation to modify the teachings of Kimoto and Barber.

Accordingly, no *prima facie* case of obviousness has been established with respect to amended independent claim 1 and dependent claims 2-9. Amended independent claims 10, 18, 27, 35, and 44, although of different scope than claim 1, patentably distinguish from Kimoto and Barber for at least the same reasons as claim 1. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of pending claims 1-5, 7, 8, 11, 12, 14, 15, 18-22, 24, 25, 28, 29, 31, 32, 35-39, 41, 42, 45, 46, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Kimoto in view of Barber.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.
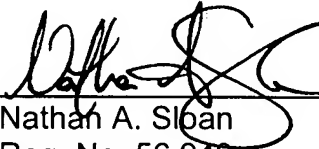
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: April 9, 2007   By:_____
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